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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,732	09/22/2003	Sang Chul Kang	JP920020142US1	9679
23550 7590 11/27/2007 HOFFMAN WARNICK & D'ALESSANDRO, LLC 75 STATE STREET 14TH FLOOR ALBANY, NY 12207			EXAMINER LE, KHANH H	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 11/27/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/667,732	Applicant(s) KANG ET AL.	
	Examiner Khanh H. Le	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>08/04/2005; and 06/07/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This Office Action is in response to the initial filing on 9/22/2003. Claims 1-18 are currently pending and considered below. Claims 1, 2, 9, 10, 17, 18 are independent.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4, 8-12, 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoyle US 6,141,010 A.

3a. Independent claims 1, 9 and 17 and dependent claim 8:

Hoyle discloses:

A method, system and computer readable medium stored thereon program instructions executable by a computer to perform providing an advertisement to a user over the Internet, the method comprising the steps of:

obtaining (*by storing operation unit which operates the CPU--Figure 1 item 14 and associated text; col. 6 line 62 to col. 7 line 13*) from a first server (Figure 1 item 22 : ADM server 2; col. 8 lines 30-40) a plurality of web page URLs (Figure 7 item "associated links" and associated text)

and associated advertisement information for each of the web page URLs (Figure 7 and associated text; e.g. "destination links", "categories")

, said advertisement information including an address at which associated advertisement data is stored (Figure 7, item "destination links", and associated text; col.16 lines 24-37) ;

and storing (*by the storing operation unit which operates the CPU-- Figure 1 item 14 and associated text; col. 6 line 62 to col. 7 line 13*) said advertisement information in a local storage

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("Banner storage" item 30 in user computer 18 in Figures 1, 2 or 4 and associated text; Figure 7 and associated text)

detecting *(by a detecting operation unit which operates the CPU--Figure 1 item 14; col. 6 line 62 to col. 7 line 13)* an URL that the user enters on a web browser (col.16 lines 24-37: 'recognizing the website being accessed") ;

retrieving *(by a retrieving operation unit which operates the CPU --Figure 1; col. 6 line 62 to col. 7 line 13)* from the local storage the advertisement information associated with the detected URL (col.16 lines 24-37);

reading from a **second server, the second server being the same as the first server** (Figure 3 item 22: ADM server 22; col.16 lines 37-52) the associated advertisement data at the advertisement address included in the retrieved advertisement information (col. 16 lines 37-52);

and displaying *(by a displaying operation unit which operates the CPU--Figure 1 item 12; col. 6 line 62.to col. 7 line 13)* the associated advertisement data in accordance with the advertisement information (col. 16 line 35).

3b. Independent claims 2, 10 and 18 and dependent claim 16:

Hoyle discloses:

A method, system and computer readable medium stored thereon program instructions executable by a computer to perform providing an advertisement to a user over the Internet, the method comprising the steps of:

obtaining from a first server (Figure 1 item 22 : ADM server 2; col. 8 lines 30-40) a plurality of web page URLs (Figure 7 item "associated links" and associated text)

and associated advertisement information for each of the web page URLs (Figure 7 and associated text; e.g. "destination links", "categories"), said advertisement information including an address at which associated advertisement data is stored (Figure 7, item "destination links", and associated text; col.16 lines 24-37);

and storing *(by the storing operation unit which operates the CPU-- Figure 1 item 14 and associated text; col. 6 line 62 to col. 7 line 13)* said advertisement information in a local storage ("Banner storage" item 30 in user computer 18 in Figures 1, 2 or 4 and associated text; Figure 7 and associated text);

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detecting (by a detecting operation unit which operates the CPU--Figure 1 item 14; col. 6 line 62 to col. 7 line 13) **an URL and a search keyword** that the user enters on a web browser (col.16 lines 24-37: 'recognizing.. the website being accessed,..the keywords used');

retrieving (by a retrieving operation unit which operates the CPU --Figure 1; col. 6 line 62 to col. 7 line 13) from the local storage the advertisement information associated with the detected URL (col.16 lines 24-37);

reading from a **second server, the second server being the same as the first server** (Figure 3 item 22: ADM server 22; col.16 lines 37-52) the associated advertisement data at the advertisement address included in the retrieved advertisement information (col. 16 lines 37-52);

and displaying (by a displaying operation unit which operates the CPU--Figure 1 item 12; col. 6 line 62 to col. 7 line 13) the associated advertisement data in accordance with the advertisement information (col. 16 line 35).

3c. Claims 3-4 and 11-12:

HOYLE discloses a method and system as in Claims 1-2 and 9-10 above and further discloses wherein the web page URLs and the search keywords are represented by regular expressions (Figure 3, e.g. URL is www.sports.com; keyword is sports or stocks).

(Note: Since the only relevant paragraph [0031] of the published version of the specification-- US 20040143496-- fails to specifically define "regular expressions", this phrase is interpreted as any expression such as a English terms e.g. "sports").

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 5-6 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoyle.

5a. Claims 5 and 13:

Hoyle discloses a method and system as in Claims 1 and 9 above and further discloses the ad data includes other data including a number of times a particular ad can be displayed (col. 15 lines 54-58; col. 12 lines 5-6).

Hoyle however does not specifically disclose the ad information includes information on an effective display period of time.

However an “effective display period of time” is only a common alternative for a number of times of display, for the same purpose of limiting the time of exposure of a particular ad so others can be displayed (Hoyle, col. 15 lines 58-59). Because it is obvious to use common alternative means to achieve the same goal, if desired, it would have been obvious to a person having ordinary skill in the art at the time the invention was made (herein a “PHOSITA”) to replace Hoyle’s number of times of display for an ad with an “effective display period of time”.

Also, Hoyle does not specifically disclose display location information of the advertisement. However it discloses a banner region 78 (col. 9 lines 26-57; Figure 5 item 78), and the ad data can includes other specifying data (col. 15 lines 54-55). Thus it would have been obvious to a PHOSITA to add to Hoyle’s ad data display location information of the ad to effect displaying the ad in the desired user screen region. As discussed in Hoyle, such display control techniques as well-known (col. 9 lines 26-57), thus obvious to implement.

5b. Claims 6 and 14:

HOYLE modified as above discussed discloses a method and system as in Claims 5 and 13 above and further discloses wherein determining if the effective display period of time for the advertisement to be displayed has expired (col. 12 lines 5-6).

6. Claims 7 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoyle as applied to claims 5 and 13 above, and further in view of Nicholas III, US 6,865,719.

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Claims 7 and 15:

HOYLE modified as above discussed discloses a method and system as in Claims 5 and 13 above.

However, Hoyle does not disclose wherein said step of displaying further comprises the step of determining if the advertisement will be displayed within a web browser or outside the web browser, based on the display location information.

However, Nicholas discloses ads shown inside or outside of the browser (Figure 4A items 408 and associated text; col. 7 lines 55 col. 8 line 8). It would have been obvious to a PHOSITA to add this teaching of Nicholas to Hoyle to allow the ad to display where the user 's focus is best (Nicholas, col. 2 lines 53-67).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Schneider, US 6973505 discloses network resource access method.

Weitzman , US 20020099605 discloses search engine for ads.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 571-272-6721. The Examiner works a part-time schedule and can normally be reached on Tuesday-Wednesday 9:00-6:00.

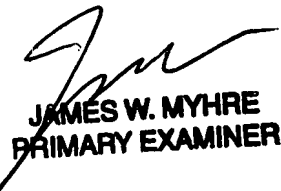
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone numbers for the organization where this application or proceeding is assigned are **571-273-8300** for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600. For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314).

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 14, 2007

KHL



JAMES W. MYHRE
PRIMARY EXAMINER